

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Bradley W. Johnson
Serial number: 10/825,490
Filed: April 15, 2004
Title: Table Bonus Game
Attorney docket number: 720.898

Group Number: 3714
Examiner: Matthew D. Hoel

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE D under 37 CFR §1.111

In response to the non-final Office Action dated November 2, 2006, please amend the Claims as indicated and consider the accompanying remarks. Please charge Applicants' Deposit Account No. 500913 for any additional fees that may be due. Also filed separately is Response E under 37 CFR §1.97(c), related to the above referenced application.

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COMPLETE LISTING OF CLAIMS

1-39. (cancelled).

40. (currently amended) A gaming device comprising:

- (A) a first game of chance having a first game outcome, the first game of chance allowing the player to place a first wager and potentially entitling the player to a first prize, the first game of chance comprising:
 - (a) a dealer position;
 - (b) a first wagering scheme;
 - (c) at least two individual card wagering positions;
 - (d) a first wager input; and
- (B) a second game of chance having a second game outcome, the second game of chance allowing the player to place a second wager and potentially entitling the player to a second prize, wherein the first game outcome and the second game outcome are independent of each other, the second game of chance comprising:
 - (a) a second wagering scheme;
 - (b) a second game play area;
 - (c) a second wager input;
 - (d) a game display located adjacent the dealer position, the game display being adapted to display the second game outcome; and
 - (e) a controller in communication with the game display, the controller being adapted to control the game display.

41. (cancelled)

42. (currently amended) The gaming device of claim 40 wherein the award of awarding the

first prize is independent of the second game outcome and the award of awarding the second prize is independent of the first game outcome.

43. (previously presented) The gaming device of claim 40 wherein the second game play area is a roulette betting area that is located between the dealer position and the card wagering position.
44. (currently amended) The gaming device of claim [144] 43 wherein the game display is a roulette wheel that is mounted above the roulette betting area.
45. (previously presented) The gaming device of claim 40 wherein the first game is blackjack.
46. (previously presented) The gaming device of claim 40 wherein the second game is roulette.
47. (previously presented) The gaming device of claim 40 wherein the player is required to wager on the first and second games of chance.
48. (previously presented) The gaming device of claim 40 wherein the player may wager on either or both of the first and second games of chance.
49. (previously presented) The gaming device of claim 40 wherein the first and second games of chance are operatively coupled to each other.
50. (previously presented) The gaming device of claim 40 wherein the first game of chance comprises a table, the first card wagering position appearing on the table.
51. (previously presented) The gaming device of claim 40 wherein the first game of chance includes a table, the second game of chance having a rotatable wheel, the rotatable wheel being mounted above the table.
52. (previously presented) The gaming device of claim 51 wherein the rotatable wheel is

mounted to the table such that it may rotate about a horizontal axis.

53. (currently amended) The gaming device of claim ~~40~~ 43, wherein the roulette betting area comprises a video display.
54. (previously presented) The gaming device of claim 40, wherein the second game has more than two outcomes.
55. (previously presented) The gaming device of claim 40 wherein the second game is keno.

56. (currently amended) A gaming device comprising:

- (A) a dealer position;
- (B) at least one game player position;
- (C) a first game of chance having a first game play area, the first game having a first game outcome, the first game allowing the player to place a first wager and potentially entitling the player to a first prize; ~~and~~
- (D) a second game of chance having a second game play area, the second game having at least three second game outcomes, wherein the first game outcome and the second game outcome are independent of each other, the second game allowing the player to place a second wager and potentially entitling the player to a second prize;
- (E) a game display located adjacent the dealer position, the game display being visible to the game player position, the game display being adapted to display the second game outcome; and
- (F) a controller in communication with the game display, the controller being adapted to randomly determine the second game outcome and to display the second game outcome on the game display.

57. (previously presented) The gaming device of claim 56 wherein the first game play area is a card wagering layout area.

58. (previously presented) The gaming device of claim 56 wherein the second game play area is a roulette betting area.

59. (previously presented) The gaming device of claim 56 wherein a roulette wheel is mounted to the gaming device.

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60. (cancelled)

61. (currently amended) A gaming method comprising:

allowing a player to play at least one game round of a game, each game round comprising:

- (A) allowing the player to place a wager on a first game of chance having a first game of chance outcome;
- (B) allowing a dealer to present the first game of chance to the player;
- (C) determining a first game of chance outcome;
- (D) if the first game of chance outcome comprises a winning outcome, awarding the player a first prize;
- (E) allowing the player to place a wager on a second game of chance having a second game of chance outcome, the second game of chance having more than two possible outcomes;
- (F) presenting the second game of chance to the player;
- (G) determining the second game of chance outcome, wherein the first game outcome and the second game outcome are independent of each other;
- (H) displaying the second game of chance outcome to the player on a game display, the game display being mounted adjacent the dealer; and
- (I) if the second game of chance outcome comprises a winning outcome; awarding the player a second prize.

62. (previously presented) The gaming method of claim 61 wherein the step of allowing the dealer to present the first game of chance to the player further comprises dealing at least one card to the player.

63. (previously presented) The gaming method of claim 61 wherein the step of presenting the second game of chance to the player further comprises rotating a wheel.
64. (cancelled)
65. (previously presented) The gaming method of claim 61, wherein the player is allowed to place a wager on the second game of chance only if the player placed a wager on the first game of chance.
66. (previously presented) The gaming method of claim 61, wherein the player is allowed to place a wager on the second game of chance regardless of whether the player placed a wager on the first game of chance.
67. (previously presented) The gaming method of claim 61 wherein the step of allowing the player to place a wager on a first game of chance having a first game of chance outcome further comprises allowing the player to place a wager on a discrete card game layout.
68. (previously presented) The gaming method of claim 61 wherein the step of allowing the player to place a wager on a second game of chance having a second game of chance outcome further comprises allowing the player to place a wager on a discrete wheel game betting layout.
69. (previously presented) The gaming method of claim 68, wherein the wheel game betting layout at least resembles a roulette betting layout.
70. (previously presented) The gaming method of claim 61 wherein the step of allowing the player to place a wager on a first game of chance having a first game of chance outcome further comprises, allowing the player to place a wager on a first wagering scheme and the step of allowing the player to place a wager on a second game of chance having a second game of chance outcome comprising allowing the player to place a wager on a

second wagering scheme, the second wagering scheme being distinct from the first wagering scheme.

71. (previously presented) The gaming method of claim 70 wherein the first wagering scheme is a blackjack betting layout.
72. (previously presented) The gaming method of claim 70 wherein the first wagering scheme is a poker card betting layout.
73. (previously presented) The gaming method of claim 61, wherein the first game of chance is blackjack.
74. (previously presented) The gaming method of claim 61, wherein the second game of chance is roulette.
75. (previously presented) The gaming method of claim 61, wherein the first game of chance is poker.
76. (cancelled).
77. (previously presented) The gaming method of claim 61, further comprising:
 - (A) displaying an image of a roulette wheel on a video display;
 - (B) spinning the roulette wheel; and
 - (C) stopping the roulette wheel.
78. (previously presented) The gaming device of claim 40 wherein the game display is mounted above the second game play area.
79. (previously presented) The gaming device of claim 40 wherein the card wagering positions and the second game play area are mounted on a table.
80. (previously presented) The gaming device of claim 79 wherein the game display is mounted above the table.

81. (previously presented) The gaming device of claim 56 wherein the game display is mounted above the first and second game play areas.

THE AMENDMENT

Claims 40, 42-59, 61-63, 65-75 and 77-81 are in the case. Claims 41, 60 and 64 have been cancelled. Claims 40, 42, 44, 53, 56 and 61 have been amended. The amendments to claims 40, 56 and 61 regarding the wording “wherein the first game outcome and the second game outcome are independent of each other” is supported by now cancelled claims 41, 60 and 64, respectively. Claims 42, 44, 53 and 61 have been amended to correct various antecedent basis inconsistencies. Claim 56 has also been amended to correct a grammatical error.

Applicant respectfully submits that the Amendment does not introduce new matter and request that the Amendment be entered.

REMARKS

1. A Brief Summary of One Embodiment of Applicants' Invention

In one embodiment of Applicant's invention a game includes a table having a card betting layout located on a surface of the table. A roulette betting layout is located on the surface of the table. A roulette wheel is mounted to the table. The game allows wagering and playing a card game and a roulette game at the same time. A dealer operates the game. The games are independent of each other (see figures 1-3 and paragraphs 39-44).

2. Rejection of claims 40-44, 46, 48-51, 54-64, 66-70, 72, 74, 75, 77 and 79 under 35 USC §103(a) as being obvious over Brosnan et al. (U.S. Patent No. 6,656,040) in view of Astaneha (U.S. Patent No. 6,302,395).

Claims 40-44, 46, 48-51, 54-64, 66-70, 72, 74, 75, 77 and 79 stand rejected under 35 USC §103(a) as being obvious over Brosnan et al. in view of Astaneha. Applicants respectfully traverse the rejection.

Brosnan et al. appears to disclose playing of multiple games on a gaming device by allowing a player to start a new game before the outcome of the previous game is completed. Brosnan et al. does not disclose a dealer position but does include a master controller and slot/video displays. Brosnan et al. emphasizes the player role in all game activities (col 15:28-40 and col 16:13-30) and is silent regarding any participation of a dealer. Brosnan et al. further makes a point of the separate and independent nature of game outcomes, even though multiple games may be played simultaneously, overlapping or sequentially and presentations of the game outcomes may appear to interact (see col 3:45-50, col 8:22-39, col 8:61-67, col 16:31-47 and Abstract). The slot and video game emphasis of Brosnan et al. is further indication of the advantages of player control during game play versus active involvement of a house dealer (the latter feature upon which Brosnan et al. is silent).

Astaneha appears to disclose a combination dice, card and roulette gambling table where the combination of the numerical values generated by a dice game, a numbered card game and a rotating wheel game is used to obtain a final game outcome. Astaneha does not disclose use of a controller to determine a game outcome or game display; instead, a dealer (e.g., turning the roulette wheel, dealing a card) or player (throwing dice) is always involved. Astaneha emphasizes the interaction between various game components in determining the final game

result, e.g., interactive result of die and card numbers, interaction of roulette and card results, interaction of roulette, card and dice results, interaction of two dice and roulette results, interaction of two cards and roulette results, interaction of two cards and die results, etc. There are no separate and independent game outcomes for the multiple individual games disclosed in Astaneha, only interactive results.

The Office relies on the combination of Brosnan et al. and Astaneha in rejecting independent claims 40, 56 and 61. Applicant respectfully submits that one of ordinary skill in the art would have no incentive to combine the cited references to arrive at Applicant's claimed invention. Astaneha teaches the advantages of simplicity and variation, e.g., interactive combination of color (cards), die numbers and the wheel aspects of roulette (see excerpt below) to overcome the disadvantages (see col 1:43-53 and col 2:33-40) of the individual games of dice (craps, too complicated) and roulette (repetitive and boring):

“... a wagering area for wagering on number combinations from an arithmetic operation of a combination of at least one number on an upper face of the at least one die, a number in an indicated segmented area [roulette] and at least one number on at least one of the cards.”(col 4:44-48 of Astaneha)

On the other hand, Brosnan et al., while allowing for multiple game outcome presentations, emphasizes that the individual game outcomes determined by the gaming machine are independent of one another and do not depend on the other game outcome presentations, see excerpt below:

“The game playing methodology in this invention allows a new game play to be initiated by a player before the game outcome presentation of a previous game has been completed. ... Once a player has initiated a game, the player may proceed to ... initiate a second game while the gaming machine is determining the game outcome and presenting the game outcome from the first game. ... However, the probability of the game outcomes for the first, second and all subsequent games are independent of one another. Thus, the probability of a particular game

outcome for a game is not affected by the game outcomes of previous games.”
(col 8:22-39 of Brosnan et al.)

The Office contends that it would have been obvious to combine the features of Brosnan et al. and Astanha to arrive at Applicant’s claimed invention. However, in order for a proper combination of references to be used to establish a *prima facie* case of obviousness, there must be (a) some suggestion or incentive disclosed in the references themselves to support such modifications based on combination of references and (b) some reasonable expectation of success resulting from the combination (see MPEP 2142 and 2143).

Further, if such a combination is to be made in any way, all of the teachings and inferences of each reference must be considered in order to determine how one of ordinary skill in the art would be influenced in arriving at a final embodiment based on the teachings of the individual references. One cannot pick and choose among the various features (i.e., ignoring some but not others) by relying on hindsight based on Applicant’s disclosure. For example, inconsistencies resulting from combination of the cited references must be evaluated in how one of ordinary skill in the art would determine the value or utility of combining the cited references (see MPEP 2143.01, II). Indeed, the proposed modifications (by the Office) cannot render the teachings of the references unsatisfactory for their intended purpose, otherwise there is no proper suggestion or motivation to make the proposed modification (see MPEP 2143.01, V). In the chart below, Applicant has summarized the different features of the games taught by the Brosnan et al. and Astanha references:

<u>Feature</u>	<u>Brosnan et al</u>	<u>Astaneha</u>
Controller	Yes	No
Slot/Video Game Play	Yes	No
Separate and Independent Game Results	Yes	No
Combination/Interactive Game Results	No	Yes
Dealer Position	No	Yes

It is apparent that there are several inconsistencies in the teachings of the individual references, e.g., involvement of a controller and slot/video game play (Brosnan et al.) versus involvement of a dealer position (Astaneha), and reliance on combination of multiple game results to determine a final prize result (Astaneha) versus an emphasis on the separate and independent game results in multiple game play (Brosnan et al.). It is evident that, even if one of ordinary skill in the art were to attempt to combine the teachings of Brosnan et al. and Astaneha, the result would not be suitable for game play as described by Applicant's claimed invention. One of ordinary skill in the art would be faced with (1) combining use of a controller (such as used in slot or video games) with dealer involvement, an apparent incompatibility, and (2) combining the use of interacting individual games results to determine a game outcome with the priority given to separate and independent game results, clearly another incompatibility. As a result, the proposed combination would change the inherent principle of operation taught by each of the individual references; therefore "... the teachings of the references are not sufficient to render the claims *prima facie* obvious ..." (see MPEP 2143.01, VI).

Based on the aforementioned incompatibilities that would result from the proposed combining of the cited references, there can be no reasonable expectation of success resulting from such combination nor any incentive to combine the references. Therefore, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and requests

withdrawal of the rejection under 35 USC §103(a) of independent claims 40, 56, 61 and their corresponding dependent claims (42-55, 57-59, 62-63, 65-75 and 77-81).

3. Rejection of claims 45, 71 and 73 under 35 USC §103(a) as being obvious over Brosnan et al. (U.S. Patent No. 6,656,040) in view of Astaneha (U.S. Patent No. 6,302,395) and further in view of Huard et al. (U.S. Patent No. 5,753,800).

Claims 45, 71 and 73 stand rejected under 35 USC §103(a) as being obvious over Brosnan et al. in view of Astaneha and further in view of Huard et al. Applicants respectfully traverse the rejection.

Based on the discussion presented above regarding independent claims 40 and 61 (from which claims 45, 71 and 73 are dependent), Applicant respectfully submits that a *prima facie* case of obviousness has not been established since “... if an independent claim is nonobvious under 35 USC §103, then any claim depending therefrom is nonobvious ...” (see MPEP 2143.03).

4. Rejection of claims 47 and 65 under 35 USC §103(a) as being obvious over Brosnan et al. (U.S. Patent No. 6,656,040) in view of Astaneha (U.S. Patent No. 6,302,395) and further in view of Adams (U.S. Patent No. 5,911,418).

Claims 47 and 65 stand rejected under 35 USC §103(a) as being obvious over Brosnan et al. in view of Astaneha and further in view of Adams. Applicants respectfully traverse the rejection.

Based on the discussion presented above regarding independent claims 40 and 61 (from which claims 47 and 65 are dependent), Applicant respectfully submits that a *prima facie* case of

obviousness has not been established since “... if an independent claim is nonobvious under 35 USC §103, then any claim depending therefrom is nonobvious ...” (see MPEP 2143.03).

5. Rejection of claims 44, 51-53, 78 and 80-81 under 35 USC §103(a) as being obvious over Brosnan et al. (U.S. Patent No. 6,656,040) in view of Astaneha (U.S. Patent No. 6,302,395) and further in view of Pohanka (U.S. Patent Des. 273,310).

Claims 44, 51-53, 78 and 80-81 stand rejected under 35 USC §103(a) as being obvious over Brosnan et al. in view of Astaneha and further in view of Pohanka. Applicants respectfully traverse the rejection.

Based on the discussion presented above regarding independent claims 40 and 61 (from which claims 44, 51-53, 78 and 80-81 are dependent), Applicant respectfully submits that a *prima facie* case of obviousness has not been established since “... if an independent claim is nonobvious under 35 USC §103, then any claim depending therefrom is nonobvious ...” (see MPEP 2143.03).

Conclusion

Based on the arguments presented above, Applicant respectfully submits that the rejections have been overcome and requests allowance of the claims.

Respectfully submitted,

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